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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,759	05/24/2001	John A. Jones	01102	9132

23338 7590 11/30/2004

DENNISON, SCHULTZ, DOUGHERTY & MACDONALD  
1727 KING STREET  
SUITE 105  
ALEXANDRIA, VA 22314

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/863,759

Applicant(s)

JONES ET AL.

Examiner

John M Winter

Art Unit

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WJW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 11 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

Claims 1-8, 11 and 12 remain pending

### *Response to Arguments*

The Applicants arguments filed on September 17, 2004 have been fully considered.

The Examiner states that the feature of "including adding to said database BIN information with respect to PIN based debit transactions successfully settled where the preliminary assessment was uncertain whereby future transactions using the particular card will be recognized as capable of settlement using the debit point of sale network." is disclosed in the newly discovered reference Bartoli et al. (US Patent 6,047,268).

See following rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes et al. (US Patent 5,745,655) in view of Thomas (US Patent 6,064,988) and further in view of Bartoli et al. (US Patent 6,047,268).

As per claim 11,

Hughes et al. ('655) discloses an automated method of card acceptance for processing of financial transactions originating at a point of sale computer system of a store site and being approved by a computer system of a remote financial institute, said method comprising; providing the primary account number to said point of sale computer system and comparing the primary account number with a database of card bank identification numbers and conducting a preliminary assessment whether the particular transaction is capable of being settled using a debit point of sale transaction network, (Figure 5A)

requesting the entry of a PIN when the preliminary assessment indicates the capability of being settled as a debit transaction and upon entry of the PIN (Figure 5B)

settling the transaction through a debit point of sale transaction network, and settling the transaction through a credit transaction network if the card is not debit capable. (Column 4, lines 21-29)

Hughes et al. ('655) does not explicitly disclose "determining a primary account number of a financial transaction card presented for payment of the transaction", Thomas ('988) discloses "determining a primary account number of a financial transaction card presented for

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payment of the transaction".(Column 5, lines 47-53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Hughes et al. ('655) method with the Thomas ('988) method in order in order to allow the merchant to obtain the customers payment.

Hughes et al. ('655) does not explicitly disclose "including adding to said database BIN information with respect to PIN based debit transactions successfully settled where the preliminary assessment was uncertain whereby future transactions using the particular card will be recognized as capable of settlement using the debit point of sale network.", Bartoli et al. ('268) discloses "including adding to said database BIN information with respect to PIN based debit transactions successfully settled where the preliminary assessment was uncertain whereby future transactions using the particular card will be recognized as capable of settlement using the debit point of sale network.".(Column 3, lines 15-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Hughes et al. ('655) method with the Bartoli et al. ('268) method in order in order to allow the merchant to process transaction more quickly.

#### ***Allowable Subject Matter***

Claims 1-8 are allowable over the prior art record.

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the

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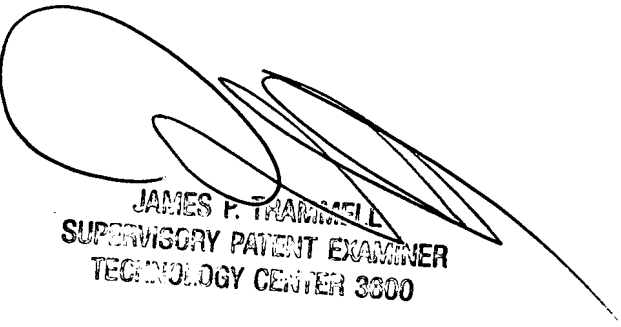
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organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

November 28, 2004



JAMES P. THARMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600